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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/390,154	09/03/1999	RAJAT MUKHERJEE	AM9-99-0080	6393

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JOHN L ROGITZ
ROGITZ & ASSOCIATES
750 B STREET SUITE 3120
SAN DIEGO, CA 92101

EXAMINER

LY, ANH

ART UNIT

PAPER NUMBER

2172

DATE MAILED: 09/03/2002

Please find below and/or attached an Office communication concerning this application or proceeding.



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Commissioner of Patents and Trademarks

Applicants' Reply Brief filed 08/11/2002 is noted and made of record.


JEAN M. CORRIELUS
PRIMARY EXAMINER

After reopening of prosecution, appellant must exercise one of the following options to avoid abandonment of the application:

- (A) file a reply under 37 CFR 1.111, if the Office action is non-final;
- (B) file a reply under 37 CFR 1.113, if the Office action is final; or
- (C) request reinstatement of the appeal.

See 37 CFR 1.193(b)(2). If reinstatement of the appeal is requested, the request must be accompanied by a supplemental appeal brief; however, no new amendments, affidavits (37 CFR 1.130, 1.131, or 1.132), or other evidence is permitted. The supplemental appeal brief must comply with the requirements of 37 CFR 1.192(c), but in doing so may incorporate by reference such parts of the previously-filed brief as may still be applicable. The arguments presented in the supplemental appeal brief need only be those relevant to the new ground(s) of rejection raised in the Office action that reopened prosecution, but the appellant should also identify all previously-raised issues and/or arguments which are still considered to be relevant. If the examiner does not consider that the supplemental appeal brief complies with the foregoing requirements, appellant should be given a 1 - month time period within which to file an amended supplemental brief under 37 CFR 1.192(d). See MPEP § 1206.

After the supplemental appeal brief is filed, the examiner may issue an answer thereto, and appellant may file a reply brief. It is also possible that, after reading the brief, the examiner may be convinced that some or all of the finally rejected claims are allowable. Where the examiner is of the opinion that some of the claims are allowable, he or she should so specify in the examiner's answer and confine the arguments to the remaining rejected claims. If the examiner finds, upon reconsideration, that all the rejected claims are allowable, or where the appellant in the brief withdraws the appeal as to some of the rejected claims by submitting an appropriate amendment and the examiner finds the remaining claims to be allowable, the examiner should allow the application.

In applications where an interference has resulted from the applicant provoking an interference with the patent which provided the basis for final rejection, the rejection based on that patent should be withdrawn and the appeal dismissed as to the involved claims.

1208.03 Reply Brief

37 CFR 1.193. *Examiner's answer and reply brief.*

(b)(1) Appellant may file a reply brief to an examiner's answer within two months from the date of such examiner's answer. See § 1.136(b) for extensions of time for filing a reply brief in a patent application and § 1.550(c) for extensions of time for filing a reply brief in a reexamination proceeding. The primary examiner must either acknowledge receipt and entry of the reply brief or withdraw the final rejection and reopen prosecution to respond to the reply brief. A supplemental examiner's answer is not permitted, unless the application has been remanded by the Board of Patent Appeals and Interferences for such purpose.

(2) Where prosecution is reopened by the primary examiner after an appeal or reply brief has been filed, appellant must exercise one of the following two options to avoid abandonment of the application:

- (i) File a reply under § 1.111, if the Office action is not final, or a reply under § 1.113, if the Office action is final; or
- (ii) Request reinstatement of the appeal. If reinstatement of the appeal is requested, such request must be accompanied by a supplemental appeal brief, but no new amendments, affidavits (§§ 1.130, 1.131 or 1.132) or other evidence are permitted.

Under 37 CFR 1.193(b)(1), appellant may file a reply brief as a matter of right within 2 months from the mailing date of the examiner's answer. Extensions of time to file the reply brief may be granted pursuant to 37 CFR 1.136(b) or 1.550(c). The primary examiner must then either: (A) acknowledge receipt and entry of the reply brief by using form paragraph 12.47 on form PTOL-90; or (B) reopen prosecution to respond to the reply brief. See MPEP § 1208.02. A supplemental examiner's answer is not permitted unless the application has been remanded by the Board for such purpose.

Amendments, affidavits, and/or other evidence must be submitted in papers separate from the reply brief, and the entry of such papers is subject to the provisions of 37 CFR 1.116 and 37 CFR 1.195. A paper that contains an amendment (or evidence) is not a reply brief within the meaning of 37 CFR 1.193(b). Such a paper will not be entitled to entry simply because it is characterized as a reply brief.

While 37 CFR 1.193(b)(1) prohibits a supplemental examiner's answer (in the absence of a remand from the Board of Patent Appeals and Interference for such purpose), an examiner may (with Supervisory Patent Examiner approval) respond to a reply brief by reopening prosecution. The acknowledgment of receipt and entry of a reply brief under 37 CFR 1.193(b)(1) is an indication by the examiner that no further response by the examiner is deemed necessary. Thus, a remand by the Board of

Patent Appeals and Interference under 37 CFR 1.193(b)(1) in an application containing an acknowledgment of receipt and entry of a reply brief under 37 CFR 1.193(b)(1) for the express purpose of a response by the examiner to the reply brief (a supplemental examiner's answer) should rarely, if ever, be necessary.

It should also be noted that an indication of a change in status of claims (e.g., that certain rejections have been withdrawn as a result of the reply brief) is not a supplemental examiner's answer and is of course permitted. Such an indication of a change in status of claims may be made on form PTOL-90.

For procedure where prosecution is reopened after a reply brief has been filed, see MPEP § 1208.02.

Form paragraph 12.47 may be used to acknowledge receipt and entry of a reply brief.

¶ 12.47 *Acknowledgment of Reply Brief*

Application No. [1]

Art Unit [2]

The reply brief filed [3] has been entered and considered. The application has been forwarded to the Board of Patent Appeals and Interferences for decision on the appeal.

Examiner Note:

1. This form paragraph is to be printed on a blank page for attachment to a PTOL-90 or PTO-90C.
2. If an amendment, an affidavit and/or a declaration has/have been filed with the reply brief, the examiner must notify the appellant in writing whether it has been entered. Unless the amendment, affidavit, and/or declaration place(s) the application in condition for allowance, entry should not be permitted. See 37 CFR 1.116 and 37 CFR 1.195. This is particularly important since a supplemental examiner's answer is not permitted, unless the application has been remanded by the Board of Patent Appeals and Interferences for such purpose. See 37 CFR 1.193(b)(1).

1209 Oral Hearing

37 CFR 1.194. *Oral hearing.*

(a) An oral hearing should be requested only in those circumstances in which appellant considers such a hearing necessary or desirable for a proper presentation of the appeal. An appeal decided without an oral hearing will receive the same consideration by the Board of Patent Appeals and Interferences as appeals decided after oral hearing.

(b) If appellant desires an oral hearing, appellant must file, in a separate paper, a written request for such hearing accompanied by the fee set forth in § 1.17(d) within two months from the date of the examiner's answer. If appellant requests an oral hearing and submits therewith the fee set forth in § 1.17(d), an oral argument may be presented by, or on behalf of, the primary examiner if considered desirable by either the primary examiner or the Board. See § 1.136(b) for extensions of time for requesting an oral hearing in a patent application and § 1.550(c) for extensions of time for requesting an oral hearing in a reexamination proceeding.

(c) If no request and fee for oral hearing have been timely filed by appellant, the appeal will be assigned for consideration and decision. If appellant has requested an oral hearing and has submitted the fee set

forth in § 1.17(d), a day of hearing will be set, and due notice thereof given to appellant and to the primary examiner. A hearing will be held as stated in the notice, and oral argument will be limited to twenty minutes for appellant and fifteen minutes for the primary examiner unless otherwise ordered before the hearing begins. If the Board decides that a hearing is not necessary, the Board will so notify appellant.

37 CFR 1.194(b) provides that an appellant who desires an oral hearing before the Board must request the hearing by filing, in a separate paper, a written request therefor, accompanied by the appropriate fee set forth in 37 CFR 1.17(d), within 2 months after the date of the examiner's answer. This time period may only be extended by filing a request under either 37 CFR 1.136(b) or, if the appeal involves a reexamination proceeding, under 37 CFR 1.550(c).

A notice of hearing, stating the date, the time, and the docket, is forwarded to the appellant in due course. If appellant fails to confirm within the time required in the notice of hearing, the appeal will be removed from the hearing docket and assigned on brief in due course. No refund of the fee for requesting an oral hearing will be made. Similarly, after confirmation, if no appearance is made at the scheduled hearing, the appeal will be decided on brief. Since failure to notify the Board of waiver of hearing in advance of the assigned date results in a waste of the Board's resources, appellant should inform the Board of a change in plans at the earliest possible opportunity. If the Board determines that a hearing is not necessary (e.g., a remand to the examiner is necessary or it is clear that the rejection(s) cannot be sustained), appellant will be notified.

If appellant has any special request, such as for a particular date or day of the week, this will be taken into consideration in setting the hearing, if made known to the Board in advance, as long as such request does not unduly delay a decision in the case and does not place an undue administrative burden on the Board.

The appellant may also file a request, in a paper addressed to the Chief Clerk of the Board, to present his/her arguments via telephone. The appellant making the request will be required to bear the cost of the telephone call.

If the time set in the notice of hearing conflicts with prior commitments or if subsequent events make appearance impossible, the hearing may be rescheduled on written request. However, in view of the administrative burden involved in rescheduling hearings and the potential delay which may result in the issuance of any patent based on the application on appeal, postponements are